

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants : Darshan Timbadia, et al.
Serial No. : 10/712,938
Filing Date : November 13, 2003
Title : SYSTEMS AND METHODS FOR
TESTING OVER A DISTRIBUTED
NETWORK
Art Unit : 3715
Confirmation No. : 9539
Attorney Docket No. : 128534-00701 (07027463) (OLD)
011948-0015-999-00701 (NEW)
Examiner : Kathleen Michele Mosser

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P. O. Box 1450
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REPLY BRIEF

Sir:

This Reply Brief is being submitted in response to the Examiner's Answer mailed on September 24, 2009.

Argument

I. There is ample support in the provisional applications for each of the three elements recited in the final wherein clause of claim 1

The Office has refused applicant's priority claim to U.S. Provisional Application No. 60/425,740, filed on November 13, 2002, based on the final wherein clause of claims 1, 13, and 20 not being supported in the provisional application. (The Examiner and applicant agree that claim 1 is exemplary. Accordingly, the language of the final wherein clause of claim 1 is discussed herein.) If the application at issue is granted priority to the provisional application, then the Ashley reference cited in the 35 U.S.C. § 103(a) rejections of the claims in the application at issue is not proper prior art. The Examiner and applicant have agreed that the final wherein clause contains three elements:

- use of objects stored on the server to recreate the examination on the testing station at the point in the examination where the failure occurred;
- the objects include an initial state object and changed state objects; and
- the user is not penalized for the time that questions are not available.

Examiner's Answer at page 5, lines 29-33. Further discussion of each of these elements is included herein.

A. Use of objects stored on the server to recreate the examination on the testing station at the point in the examination where the failure occurred

The Examiner agrees that this element is properly supported by the provisional application. Examiner's Answer at page 6, lines 1-4.

B. The objects include an initial state object and changed state objects

In applicant's Appeal Brief, support was cited for both initial state objects and changed state objects. The Examiner's Answer does not comment on applicant's noted support for changed state objects. Therefore, it is assumed that the Examiner agrees that changed state objects are properly supported.

In citing support for initial state objects, applicant's Appeal Brief cited to a portion of the provisional application describing the transmission of an initial state object from a testing station to a service center at page 10, line 26 to page 11, line 4 of the provisional application. The Examiner's Answer does not appear to contest that this portion of the provisional application describes an initial state object, as the Examiner's Answer characterizes the portions of the provisional application cited to by applicant stating, "The citation describes the first transmission of the test state from the testing station to the central server and depends on the potential situation where no new change of state has occurred including the absence of response data." Examiner's Answer at page 6, lines 8-10.

It is unclear to what part of applicant's argument on element B the Examiner objects. The issue is whether initial state objects are properly supported by the provisional application. The Examiner's Answer cites to examples in the non-provisional application where the initial state object is transmitted from a central server to a testing station. Examiner's Answer at page 6, lines 14-32. The Examiner's Answer then complains, "The provisional application fails to provide any support for an object created at the central server and then transmitted to the testing station in the manner the initial state object is described in the instant application." Examiner's Answer at p. 9.

The examiner's above-noted complaint -- "The provisional application fails to provide any support for an object created at the central server and then transmitted to the testing station *in the manner the initial state object is described in the instant application*" – is erroneous as a matter of law. The question is not whether the provisional application describes an embodiment in the same manner in which it is described in the non-provisional application; the question is whether the provisional application sufficiently supports the subject matter being claimed. At least for reasons explained above, the provisional application indeed provides sufficient support for subject matter being claimed. To establish a claim for priority, there is no requirement that a provisional application describe an embodiment in the same way it is described in non-provisional application – the examiner has cited no legal authority for such a proposition, and it is respectfully submitted that there is no such requirement.

Further, the examiner's criticism is factually without merit. Whether the initial state object is initially transmitted from a testing station to a server or from a server to a testing station, the result of the transmission is that the initial state object is stored at both the testing station and the server. The initial test state may then be used by the server to recreate the examination on the testing station at the point in the examination where the failure occurred, as claimed. Claim 1 does not contain any limitations regarding from where the initial state object originates. Because both the provisional application and the non-provisional application describe an initial state object stored on the server, the second claim element is properly supported.

Moreover, in seeking to narrowly limit the initial state object recited in the claims to a particular initial test state described in the instant application, the Examiner's Answer errs by attempting to improperly read into the claim a limitation from the specification. The limitation at issue reads, "wherein upon failure of the testing station, an initial state object and changed state

objects stored on the server are used to recreate the examination on the testing station at the point in the examination where the failure occurred, and wherein the user will not be penalized for the time that questions are not available.” Notably, this limitation does not state that the initial state is created at the central server and then transmitted to the testing station. The examiner’s attempt to read that limitation into the claim in alleging that the claimed subject matter is not entitled to its priority date is plainly erroneous. *See In re Winkhaus*, 188 USPQ 129, 131 (CCPA 1975) (“As we have often held, we will not read into claims in pending applications limitations from the specification.”).

C. The user is not penalized for the time that questions are not available

The provisional application states, “In step 220, the testing station 130a transmits the test state, including an elapsed time.” Provisional Application at page 10, lines 29-30. “In step 350, the service center 120a transmits the stored test state to an operable testing station where the user can resume taking the test.” Provisional Application at page 11, lines 25-26. “The elapsed test time takes into consideration any amount of time that a test is unavailable to the user while the test is being administered... If the user is allotted a predetermined amount of time to take the test, the user will not be penalized for the time the questions are not available to the user.” Provisional Application at page 10, lines 13-19.

The provisional application states that elapsed time is tracked in the stored test state, that the user resumes taking the test based on the stored test state, and that the elapsed time takes into consideration **any** amount of time that a test is unavailable to the user and the user will not be penalized for the time the questions are not available to the user. Thus, the user not being

penalized for the time that questions are not available is clearly supported by the provisional application.

Because all three of the elements of the last wherein clause of claim 1 are properly supported by the provisional application, it is submitted that the application at issue should be granted priority to the provisional application. Because the instant application is entitled to the benefit of its priority date, Ashley is not proper prior art, and the 35 U.S.C. § 103(a) rejections of the pending claims must fall.

II. The Examiner's Use of Official Notice Was Properly Traversed, is Improper, and is Squarely Inconsistent with the Office's Contention that Subject Matter at Issue is Not Supported by Applicants' Own Provisional Application

The Examiner's Answer asserts at page 4, "Ashley, like Kershaw fails to explicitly state that the student is not penalized for the time that questions are not available. The applicant has admitted that such a feature is well known in the art of standardized testing. (Note admission was made through lack of adequately traversing the official notice made in the final rejection dated January 7th, 2009)." First, the Official Notice was indeed properly traversed in the Response filed March 5, 2009, at page 8. Indeed, applicants pointed out the facial inconsistency between the examiner's use of official notice in contending, on one hand, that it is well known that "the student is not penalized for the time that questions are not available," while asserting, on the other hand, that such feature is not supported by applicant' own provisional application, which contained ample explicit textual support for such. Applicant stated, in traversing the official notice, "Applicants cannot fail to note this portion of the claims so evidently and precisely enabled by the specification [referring to the just described provisional application] is

also the same portion of the claims for which the Examiner has relied upon official notice. Per MPEP 2144.03, thus traverse such taking of official notice as improper as lacking sufficient documentary evidence.” Response of March 5, 2009, at p. 8. In response to applicant’s specific criticism of official notice, the Office erroneously stated, “In challenging the official notice the applicant has merely stated that the claimed feature is not of such [notorious] capable of instant and unquestionable demonstration. Aside from this general allegation the applicant has failed to show rationale, finding or logic is improper.” Advisory Action of March 24, 2009, at p. 2. Contrary to the examiner’s assertion, applicant’s traversal quoted above shows that the traversal provided more than a mere, general allegation that the taking of official notice was improper. Rather, the traversal highlighted the facial inconsistency in the examiner’s logic of asserting that the feature was unquestionably and notoriously known in the prior art (which was silent about the feature), while contending that the applicant’s provisional application, which provided textual support for the feature, nevertheless was not sufficient to establish a priority for the feature. As such, the examiner’s reliance upon official notice is as untenable now as it was when applicant properly traversed it.

Further, the examiner’s attempted use of official notice is improper because it is being used as principle evidence in a rejection in violation of the restrictions placed upon its use. As stated at MPEP § 2144.03, “Official Notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.” Additionally, MPEP § 2144.03 states, “It is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.” MPEP 2144.03(A) citing *In re Zurko*, 258 F.3d at

1385, 59 USPQ2d at 1697. Here, the examiner and applicant are debating the “wherein” clause of claims 1, 13, and 20, both from the standpoint of what the prior art teaches and what applicants’ provisional application discloses. The examiner purports to rely upon official notice for a feature, for which the cited prior art is silent, while contending that applicants’ provisional application containing textual support for the feature is insufficient to establish a priority date. The examiner’s use of official notice is unquestionably being used as principle evidence in the rejection and, as such, is facially improper.

Conclusion

It is respectfully submitted that the pending claims are allowable for the reasons stated in the Appeal Brief in addition to the reasons stated above. It is respectfully requested that the Board direct the examiner to issue a Notice of Allowance for the pending claims.

The Commissioner is authorized to charge any fees that may be required by this paper to Jones Day Deposit Account No. 50-3013 to maintain the pendency of this application.

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